

The opinion in support of the decision being entered  
today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* ROBERT B. BARNHILL, JR.,  
JAMES R. GAARDER,  
THOMAS E. THROCKMORTON,  
CHRISTOPHER JOSEPH VAUGHAN,  
MATTHEW J. TOLL, and  
BRYON BRONNER

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Appeal No. 2007-3077  
Application No. 09/609,336  
Technology Center 3600

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Decided: September 26, 2007

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Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and  
DAVID B. WALKER, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal from a decision of the Examiner rejecting claims  
1-22. 35 U.S.C. § 134 (2002). We have jurisdiction under 35 U.S.C.  
§ 6(b) (2002).

The invention is directed to a computer method and system for ordering products online. The invention involves the use of a worksheet displayed on a monitor of a client device having fields which the customer completes.

Fig. 16 of the current application's Specification is reproduced below.

TESCO.com | About TESCO.com | Contact Us | Products | My Account | Track Order | Log Off

**TESCO** **My Worksheet**

My Worksheet Find Order My Account

Current Worksheet: MY WORKSHEET  
Owner: admin

Line No.	TESCO Part No.	Order Qty.	Unit of Measure	Description
<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>
<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>
<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>
<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>
<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>
<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>
<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>
<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>	<input type="text"/>

F16.16

Fig. 16 of the current application shows a worksheet.

Claims 1-22 are rejected under 35 U.S.C. §102(e) as being anticipated by Kenney (US Patent No. 6,026,376).

Appellants argue the claims in the following groups:

- Claims 1, 5, and 6 (Br. 7-10);
- Claim 2 (Br. 10-11);
- Claim 3 (Br. 11);

- Claim 4 (Br. 12);
- Claims 7 and 8 (Br. 12);
- Claims 9-11 (Br. 13);
- Claims 12 and 13 (Br. 13);
- Claim 14 (Br. 14);
- Claim 15-20 (Br. 14-15);
- Claim 21 (Br. 15-16); and,
- Claim 22 (Br. 16).

Because Appellants argue claims 1, 5, and 6; 7 and 8; 9-11; 12 and 13; and 15-20 as groups, pursuant to the rules, the Board selects representative claims 1; 7; 9; 12; and, 15 to decide the appeal with respect to the rejection of each of these groups and the remaining claims in each group will stand or fall with their selected respective claim. 37 C.F.R. § 41.37(c)(1)(vii) (2006).

We REVERSE and REMAND.<sup>1</sup>

#### B. Findings of Fact

The record supports the following findings of fact (FF) by a preponderance of the evidence.

#### *Claims 1, 5, and 6*

1. Claim 1 reads as follows:

1. A method for ordering products online, comprising:
  - a) providing a server system for connection to a client system, said server system including product and order databases;
  - b) allowing the client system to be connected to the

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<sup>1</sup> Our decision will make reference to Appellants' Appeal Brief ("Br.," filed February 14, 2006) and the Examiner's Answer ("Answer," mailed March 2, 2007).

server system;

c) displaying on the client system a worksheet having rows and columns, two of said columns comprising empty fields;

d) allowing the customer operating the client system to build the worksheet with products desired to be ordered by filling in the empty fields with the product stock number included in the product database and corresponding quantities; and

e) allowing the customer to submit the worksheet to the server system to obtain a quote as to product price and availability or direct delivery by ordering the products listed thereon.

2. The Examiner found that Kenney describes all the elements of claimed invention, as follows:

Referring to claim 1. Kenney discloses a method for ordering products online (Abstract), comprising:

- Providing a server system for connection to a client system, said server system including product and order databases (Figure 3<sup>2</sup>);

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<sup>2</sup> Figure 3 of Kenney is reproduced below.



Figure 3 of Kenney shows an illustrative screen display.

- Allowing the client system to be connected to the server system (Figure 3);
- Displaying on the client system a worksheet having rows and columns, two of said columns comprising empty fields.(Figure 9<sup>3</sup>);
- Allowing a customer operating the client system to build the worksheet with products desired to be ordered by filling in the empty fields with the product stock number included in the product database and corresponding quantities (Figure 10A<sup>4</sup> and Figure 10B<sup>5</sup>); and

<sup>3</sup> Figure 9 of Kenney is reproduced below.

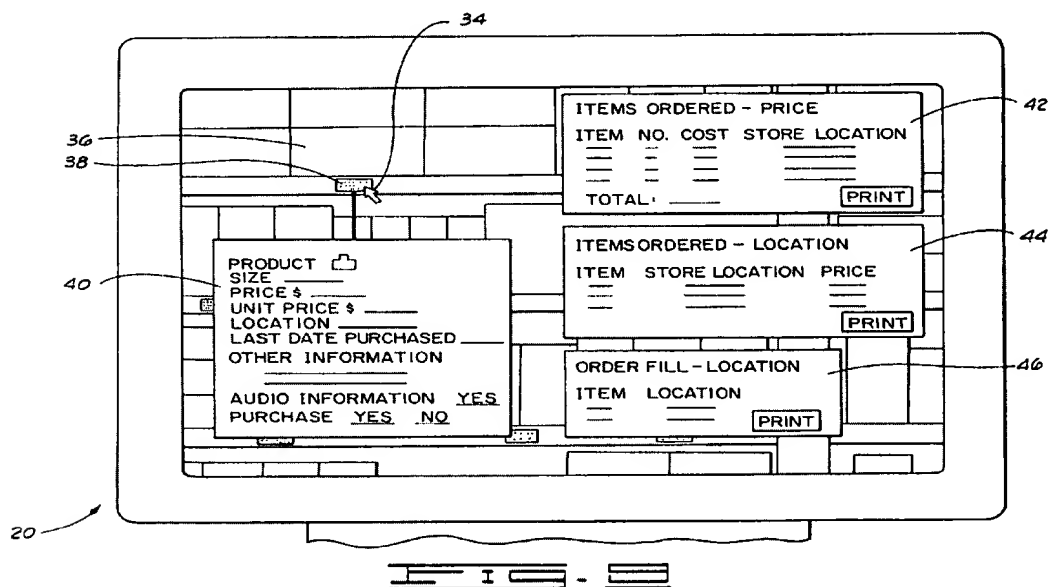


Figure 9 of Kenney shows an illustrative screen display.

<sup>4</sup> Figure 10A of Kenney is reproduced below.

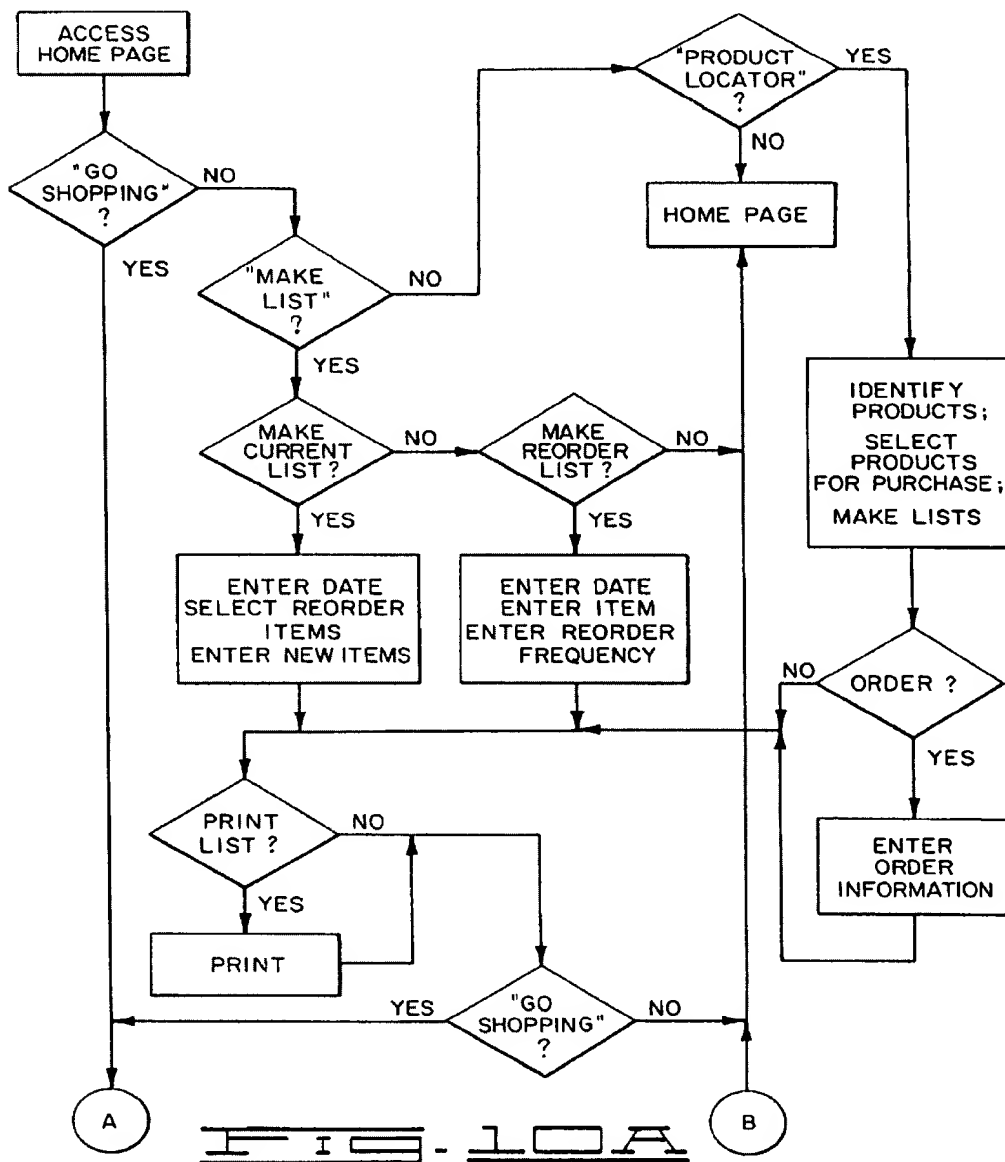


Figure 10A of Kenney shows a flowchart of the Kenney process.

- Allowing the customer to submit the worksheet to the server system to obtain a quote as to product price and availability or direct delivery by ordering the products listed thereon (Figure 10A and Figure 10B).

Answer 4.

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<sup>5</sup> Figure 10B of Kenney is reproduced below.

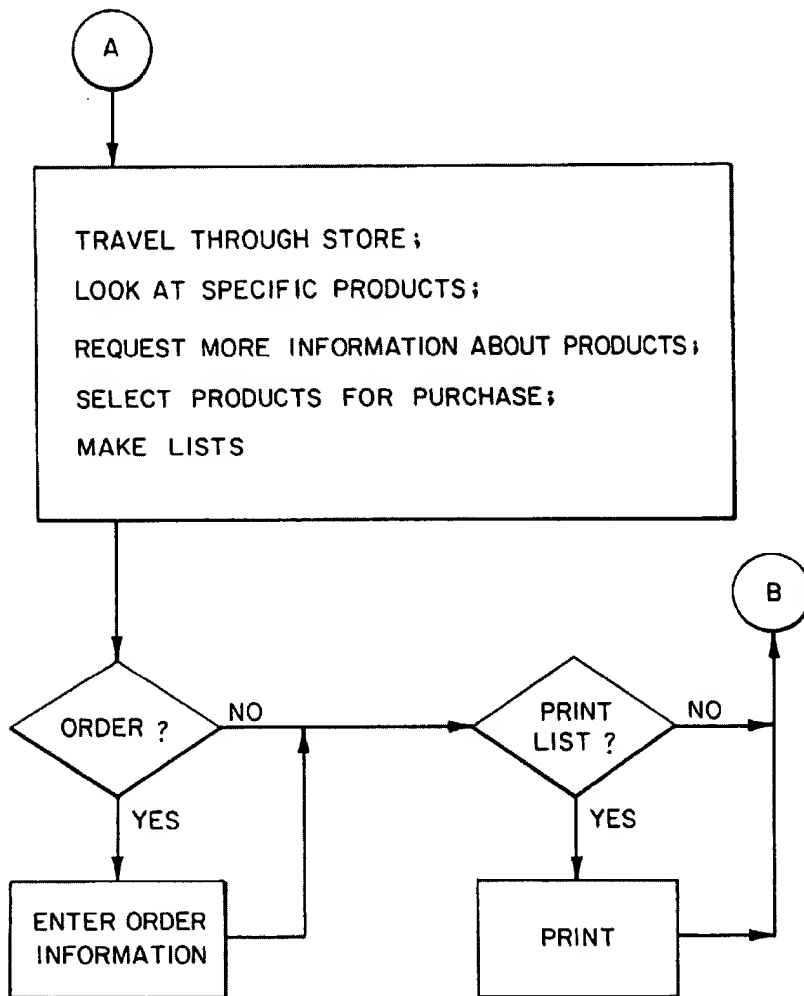


FIG. 10B

Figure 10B of Kenney shows a flowchart of the Kenney process.

3. Appellants argued that Kenney does not show a worksheet having rows and columns and two of the columns comprising an empty field, i.e., step c) of claim 1. Br. 7. Appellants stated that Figure 9 (see footnote 3 of this Decision) shows items 42, 44, and 46 which are not worksheets and do not have empty fields. Br. 7. Appellants argued that “Appellants’ worksheet eventually becomes a list after the empty fields are filled in with items he wishes to order.” Br. 8. Appellants argued that “Kenney does not disclose a worksheet that the shopper can interact with directly by filling in blank fields.” Br. 8.

4. Appellants argued that Kenney does not show step d) of claim 1” “allowing the customer operating the client system to build the worksheet with products desired to be ordered by filling in the empty fields with the product stock number included in the product database and corresponding quantities.” According to Appellants, Figs. 3 and 10A show ways a shopper can select to make a purchase. Br. 8. “No worksheet with two columns with blank fields is presented to the shopper to be filled in. Since there is no worksheet with empty fields, there can be no disclosure of the step of allowing the customer to build the worksheet by filling in the empty fields with product stock number and quantities.” Br. 8.

5. Kenney explains that a shopper can move about a virtual store displayed on a computer screen whereby “products can be selected for purchase such as entering data through the product information window 40 as shown in Fig. 9 [see footnote 3 of this Decision]. ... A selection can then be automatically added to one or more lists ... alphabetical (42), by store location (44), or by warehouse location (or other “order fill” location) (46).



... The programming for the computer 18 or 20 can also allow the shopper to add notes to any of the lists ... ." Col. 10, ll. 45-63.

6. Accordingly, Kenney discloses filling and building up a screen displayed on a client system. The screen shown in Fig. 3 of Kenney has field 40 in which the customer enters data and fields 42, 44, and 46 which receive data for lists from 40 as well as any notes the customer wishes to input. There is no mention of stock numbers.

7. Fig. 3 of Kenney shows a screen divided in rows and columns with at least two columns comprising empty fields, one column containing field 40 and the other column containing fields 42, 44, and 46.

8. The Specification defines "worksheet" as the "stage of the website through which registered customers input SKUs and quantities to be ordered, determine product price and availability, find products, retrieve other worksheets or template and edit for ordering purposes and other functions." Specification 7: 17-21. Fig. 16 in the Specification (see supra) illustrates an example of a "worksheet."

9. Fig. 9 appears to show a "worksheet" as the Specification defines it with the extent of a field to fill in SKUs.

### *Claim 2*

10. Claim 2 reads as follows:

2. A method as in claim 1, wherein the worksheet is built by keying in stock numbers for the products included in the product database.

11. The Examiner found that Kenney describes all the elements of claimed invention, as follows:

Referring to claim 2. Kenney further discloses a method wherein the worksheet is built by keying in stock numbers for the products included in the product database (column 10, lines 45-63).

Answer 4.

12. Column 10, lines 45-63, of Kenney reads:

As the shopper moves through the virtual store displayed via the computer **20**, products can be selected for purchase such as by entering data through the product information window **40** as shown in FIG. **9** (i.e., by selecting “yes” after “purchase”) or by single or double clicking on the product or the “hot spot” in a distinctive manner from that used for calling up the product information. A selection can then be automatically added to one or more lists, examples of which are shown in FIG. **9**. For example, the lists can be alphabetical (**42**), by store location (**44**), or by warehouse location (or other “order fill” location (**46**)). At least a list such as list **30** also automatically lists the number of items ordered, the unit cost and/or the total for each product, and a running total for the entire list. The programming for the computer **18** or **20** can also allow the shopper to add notes to any of the lists (e.g., an instruction for the person filling the order regarding what to do if a particular selection is not available); entering a note can be by any suitable means of the system, such as by entering text through the keyboard **20**.

13. Appellants argued that “Kenney does not disclose the shopper keying in stock numbers.” Br. 10.

14. Column 10, lines 45-63, of Kenney does not explicitly describe stock numbers and thus the Examiner has not shown that Kenney explicitly describes the claimed subject matter.

*Claim 3*

15. Claim 3 reads as follows:

3. A method as in claim 1, wherein the worksheet is built by searching the product database by category and adding the product found to the worksheet.
16. The Examiner found that Kenney describes all the elements of claimed invention, as follows:

Referring to [claim 3]. Kenney further discloses a method wherein the worksheet is built by searching the product database by:.

- Category and adding the product found to the worksheet (column 4, lines 1-19, "Unique items such as flowers or vegetables could be ordered by category, number, and total cost or amount required."). ...

Answer 4.

17. Column 4, lines 1-19, of Kenney reads:

The additional information concerning an item includes any information desired. Examples are product size, price, unit price, list purchase date, location in the store, additional product advertisement including audio information, information concerning other sizes or related products available and a "yes" or "no" to order or place an item on a list. From the running list of items selected for purchase, additional list can be automatically created. One such list could include a list of items ordered with the cost of each, the running total cost, and store location. A list arranged in order of store location could be selected for use in speeding time required for obtaining the items while in the actual store. If the order is to be filled by another party, the list could order the items for selecting from a warehouse or other storage location. Items which must be weighed or selected on a weight basis could be estimated based upon prior purchase history. Unique items such as flowers or vegetables could be ordered by category, number, and total cost or amount required (if applicable).

18. Appellants argued that “[t]here is no disclosure that Kenney shows a worksheet built by searching the product database by category and adding the product to the worksheet.” Br. 11.

19. Column 4, lines 1-19, of Kenney does not explicitly describe searching a database and thus the Examiner has not shown that Kenney explicitly describes the claimed subject matter.

*Claim 4*

20. Claim 4 reads as follows:

4. A method as in claim 1, wherein the worksheet is built by searching the product database by manufacturer part number and adding the product found to the worksheet.

21. The Examiner found that Kenney describes all the elements of claimed invention, as follows:

Referring to [claim 4]. Kenney further discloses a method wherein the worksheet is built by searching the product database by:.

- ...
- Manufacturer part number and adding the product found to the worksheet (column 4, lines 1-19, "Unique items such as flowers or vegetables could be ordered by category, number, and total cost or amount required.").
- ...

Answer 4-5.

22. Column 4, lines 1-19, of Kenney reads:

The additional information concerning an item includes any information desired. Examples are product size, price, unit price, list purchase date, location in the store, additional product advertisement including audio information, information

concerning other sizes or related products available and a “yes” or “no” to order or place an item on a list. From the running list of items selected for purchase, additional list can be automatically created. One such list could include a list of items ordered with the cost of each, the running total cost, and store location. A list arranged in order of store location could be selected for use in speeding time required for obtaining the items while in the actual store. If the order is to be filled by another party, the list could order the items for selecting from a warehouse or other storage location. Items which must be weighed or selected on a weight basis could be estimated based upon prior purchase history. Unique items such as flowers or vegetables could be ordered by category, number, and total cost or amount required (if applicable).

23. Appellants argued that col. 4, ll. 1-19, does “not disclose the step of searching the product database by manufacturer part number and adding the product found to the worksheet.” Br. 12.

24. Col. 4, ll. 1-19, of Kenney does not explicitly describe searching a product database by manufacturer part number and adding the product found to the worksheet and thus the Examiner has not shown that Kenney explicitly describes the claimed subject matter.

*Claims 7 and 8*

25. Claim 7 reads as follows:

7. A method as in claim 1, wherein the worksheet is built by cloning another worksheet.

26. The Examiner found that Kenney describes all the elements of claimed invention, as follows:

Referring to [claim 7]. Kenney further discloses a method wherein the worksheet is built by:

...;  
Cloning another worksheet (column 11, lines 8-20, "...install a reorder list.");  
... .

Answer 5.

27. Column 11, lines 8-20 of Kenney read:

Referring to FIG. 10A, to make a current list, the shopper enters the current date, selects any reorder items from an existing reorder list, enters new items to be selected and then controls the computer 20 to automatically organize in the manner the shopper wants (e.g., by location in the store or by price or alphabetically as illustrated in FIG. 9) and print the list if desired. The shopper can then end the session or "go shopping" to see if additional items are needed.

28. Appellants argued that col. 11, ll. 8-20, do "not disclose the step of cloning a product order." Br. 12.

29. Col. 11, ll. 8-20, does not explicitly describe cloning and thus the Examiner has not shown that Kenney explicitly describes the claimed subject matter.

*Claims 9-11*

30. Claim 9 reads as follows:

9. A method as in claim 1, wherein the worksheet is built by importing a template.

31. The Examiner found that Kenney describes all the elements of claimed invention, as follows:

Referring to [claim 9]. Kenny further discloses a method wherein the worksheet is built by:

- Importing a template (column 11, lines 8-20);

... .

Answer 5.

32. Appellants argued that col. 11, ll. 8-20, do “not disclose the step of importing a line item from a previous product order, or importing a line item from a template.” Br. 13.

33. Col. 11, ll. 8-20, does not explicitly describe importing a line item from a previous product order, or importing a line item from a template.

*Claims 12-13*

34. Claim 12 reads as follows:

12. A method as in claim 1, wherein the worksheet is built by loading a template into the worksheet and editing each line item as desired.

35. The Examiner found that Kenney describes all the elements of claimed invention, as follows:

Referring to claim 12. Kenny further discloses a method wherein the worksheet is built by loading a template into the worksheet and editing each line item as desired (column 11, lines 8-34).

Answer 5.

36. Column 11, lines 8-34, of Kenney reads:

Returning to the home page **24** shown in FIG. 3, one or more list forms is displayed at the respective computer **20** if the shopper selects “make list.” These can be of the same type shown in FIGS. 5 and 9 and can allow the shopper either to create a current list or to install a reorder list.

Referring to FIG. 10A, to make a current lists, the shopper enters the current date, selects, any reorder items from an existing reorder list, enters new items to be selected and then controls the computer **20**, to automatically organize in the manner the shopper wants (e.g., by location in the store or by

price or alphabetically as illustrated in FIG. 9) and print the list if desired. The shopper can then end the session or “go shopping” to see if additional items are needed.

To make a reorder list, the shopper enters the current date, the item to be reordered and information regarding the reorder frequency, and stores the reorder list in memory in either the computer 20 or the computer 18. The list can be printed, and the shopper can then “go shopping” or end the session as desired. An example of a resultant output based on this type of list is shown in FIG. 5 by list 30, which shows items to be reordered as of the current date. Such a list 30 can be defined by the foregoing to have a predetermined order frequency or a list can be automatically maintained based on actual ordering history (e.g., each time an actual order list is made, the historical list updates and determines ordering frequency such as by computing an average time between purchases of the same product).

37. Appellants argued that col. 11, ll. 8-34, do “not disclose the step of loading a template into the worksheet.” Br. 13.

38. Col. 11, ll. 8-34, does not explicitly describe loading a template into the worksheet and thus the Examiner has not shown that Kenney explicitly describes the claimed subject matter.

#### *Claim 14*

39. Claim 14 reads as follows:

14. A method as in claim 1, and further comprising reserving the quote for a predetermined period of time.

40. The Examiner found that Kenney describes all the elements of claimed invention, as follows:



Referring to claim 14. Kenny further discloses a method comprising reserving the quote for a predetermined period of time (column 11, lines 8-34).

Answer 5.

41. Appellants argued that col. 11, ll. 8-34, do “not disclose the step of reserving the quote for a predetermined period of time.” Br. 14.

42. Col. 11, ll. 8-34, does not explicitly describe reserving a quote for a predetermined period of time and thus the Examiner has not shown that Kenney explicitly describes the claimed subject matter.

*Claim 15-20*

43. Claim 15 reads as follows:

15. A client server system for ordering products online, comprising:

- a) a client server system including a database for products ;
- b) said system including means for displaying a worksheet on a client system;
- c) said worksheet including empty fields for entry by the customer of stock numbers and corresponding quantities of the products to be ordered;
- d) means for searching for a product from said database and adding the product. to the worksheet; and
- e) means for submitting the filled-in worksheet to order the products listed thereon.

44. The Examiner found that Kenney describes all the elements of claimed invention by arguing that claim 15 was rejected “under the same rationale as set forth above in claim 1.” Answer 6.

45. Appellants make the same argument as were made with respect to claim 1. Br. 14-15. See FF 1-9.

*Claim 21*

46. Claim 21 reads as follows:

21. A website as in claim 20, wherein:

- a) said software includes a presentation layer;
- b) a business layer communicating with said presentation layer; and
- c) a data layer communicating with said business layer.

47. The Examiner found that Kenney describes all the elements of claimed invention, as follows:

Referring to claim 21. Kenney further discloses a website wherein:

- Said software includes a presentation layer (Figure 1<sup>6</sup>);
- A business layer communicating with said presentation layer (Figure 2); and
- A data layer communicating with said business layer (Figure 2).

Answer 6.

<sup>6</sup> Fig. 1 of Kenney is reproduced below.

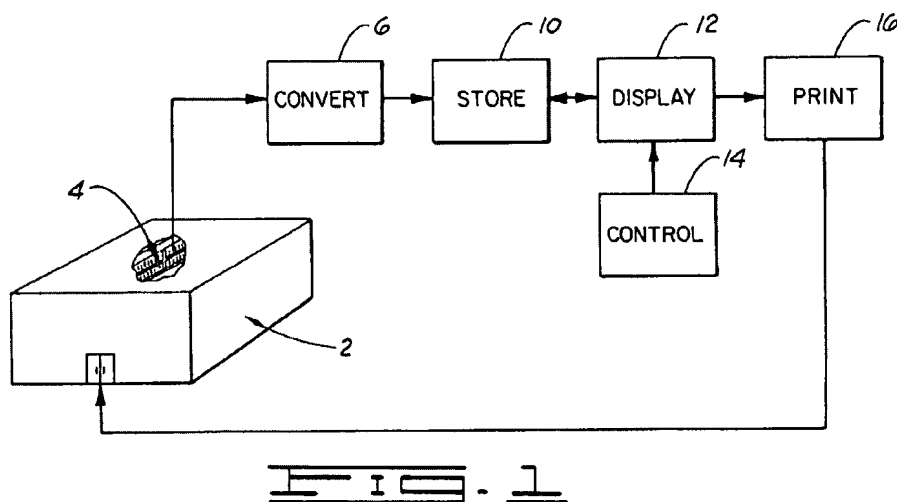


Fig.1 of Kenney shows a block diagram of the Kenney method.

48. Appellants argued that “Kenney does not disclose a software with a presentation layer, a business layer communicating with the presentation layer and a data layer communicating with the business layer.” Br. 15.

49. Figs. 1 and 2 of Kenney do not explicitly describe a software with a presentation layer, a business layer communicating with the presentation layer and a data layer communicating with the business layer and thus the Examiner has not shown that Kenney explicitly describes the claimed subject matter.

#### *Claim 22*

50. Claim 22 reads as follows:

22. A monitor display in a client system for ordering products online, comprising:

- a) worksheet including rows and columns; and
- b) said worksheet including empty fields for entry of stock numbers and corresponding quantities of the products to be ordered.

51. The Examiner found that Kenney describes all the elements of claimed invention by arguing that claim 22 was rejected “under the same rationale as set forth above in claim 1.” Answer 6.

52. Appellants make the same argument as were made with respect to claim 1. Br. 16. See FF 1-9.

#### C. Principles of Law

1. Anticipation is a question of fact. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

2. It is well settled that in order for the examiner to establish a *prima facie* case of anticipation, each and every element of the claimed invention, arranged as required by the claim, must be found in a single prior art reference, either expressly or under the principles of inherency. *See generally, Schreiber*, 128 F.3d at 1477, 44 USPQ2d at 1431; *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677-78, 7 USPQ 1315, 1317 (Fed. Cir. 1988); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).
3. There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).
4. "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).
5. "To invalidate a patent by anticipation, a prior art reference normally needs to disclose each and every limitation of the claim. ... However, a prior art reference may anticipate when the claim limitation or limitations not expressly found in that reference are nonetheless inherent in it. ... Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1946 (Fed. Cir. 1999).
6. "If the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if that element is

`inherent' in its disclosure. To establish inherency, the extrinsic evidence `must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.' ... `Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

#### D. Analysis

We will not sustain the rejection. The rejection is under 35 U.S.C. §102 and thus the claims are rejected on the ground that Kenney anticipates the claimed subject matter. Accordingly, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention.

We agree with the Examiner's analysis that Kenney shows a method and system whereby a client computer displays a worksheet having columns and rows with fields in at least two columns that a customer fills. Appellants' central argument that this limitation is not disclosed in Kenney is not persuasive. The facts (FF 1-9) clearly lead to the conclusion that Kenney explicit describes such a worksheet. We also add that some of Appellant's arguments on this point are not commensurate in scope with what is claimed. *In re Self*, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982).

Appellants argue that "Kenney does not disclose a worksheet that the shopper can interact with directly by filling in blank fields." Br. 8. FF 3.

There is nothing in the claim to suggest that the shopper interacts with the worksheet to *directly* fill in blank fields.

However, there are a number of details set forth in the claims that Kenney does not explicitly teach. We agree with Appellants that Kenney does not explicitly describe any of the following subject matter recited in the claims:

- Claims 1, 5, and 6: “allowing the customer operating the client system to build the worksheet with products desired to be ordered by filling in the empty fields *with the product stock number included in the product database* and corresponding quantities;”
- Claim 2: “keying in stock numbers for the products included in the product database;”
- Claim 3: “searching the product database by category;”
- Claim 4: “searching the product database by manufacturer part number;”
- Claims 7 and 8: “cloning another worksheet;”
- Claim 9-11: “importing a template;”
- Claims 12-13: “loading a template into the worksheet and editing each line item as desired;”
- Claim 14: “reserving the quote for a predetermined period of time;”
- Claim 15-20: “said worksheet including empty fields for entry by the customer of stock numbers and corresponding quantities of the products to be ordered;”
- Claim 21: “a) said software includes a presentation layer;  
b) a business layer communicating with said presentation layer; and  
c) a data layer communicating with said business layer” and,

- Claim 22: “worksheet including empty fields for entry of stock numbers and corresponding quantities of the products to be ordered.”

Since there is no explicit teaching of these claimed limitations in Kenney, the only question is whether, in anticipating the claimed subject matter, Kenney describes the afore listed claimed subject matter under principles of inherency. Under that theory, anticipation of the subject matter will have been established if the Examiner shows they *necessarily follow* from the teachings of Kenney and thus are inherent to the Kenney method/system. We find that the Examiner has made no such showing.

We observe that the Examiner responded to Appellants’ arguments in the Brief by arguing, in effect, that Kenney is *capable* of including the afore listed claimed subject matter. For example, in response to Appellants’ argument that Kenney does not disclose the subject matter of claim 4 (“searching the product database by manufacturer part number”), the Examiner pointed out that Kenney discloses (col. 4, ll. 1-19) that “flowers or vegetables could be ordered by ... *number* ... .” Answer 9 (Examiner’s emphasis). However, since not every number for an item is a manufacturer part number, the Examiner has actually shown that “searching the product database by manufacturer part number” does not *necessarily follow* from, and thus is not inherent to, the teaching in Kenney of ordering an item by *number*. (Furthermore, the Examiner fails to show where in Kenney a database is described.) The Examiner’s apparent reasoning that the Kenney method/system is *capable* of including the characteristics claimed appears to be rational. But the question before us is not one of obviousness but one of anticipation. Under the theory of inherency, inherency may not be

established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

## REMAND

Notwithstanding that we reverse the rejections of the claims, we nevertheless remand the application to the Examiner to consider whether claims 1-22 should be rejected over Kenney in view of what was well known to one of ordinary skill in the art at the time the application was filed under 35 U.S.C. §103(a) rather than 35 U.S.C. §102(e).

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). *See also KSR*, 127 S.Ct. at 1734, 82 USPQ2d at 1391 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 18, 148 USPQ at 467.



In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 1739, 82 USPQ2d at 1395, and discussed circumstances in which a patent might be determined to be obvious.

In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 127 S.Ct. at 1739, 82 USPQ2d at 1395 (citing *Graham*, 383 U.S. at 12, 148 USPQ at 464 (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

*Id.* at 1740, 82 USPQ2d at 1396. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

The Supreme Court made clear that “[f]ollowing these principles may be more difficult in other cases than it is here because the claimed subject matter may involve more than the simple substitution of one known element

for another or the mere application of a known technique to a piece of prior art ready for the improvement.” *Id.* The Court explained, “[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *Id.* at 1740-41, 82 USPQ2d at 1396. The Court noted that “[t]o facilitate review, this analysis should be made explicit.” *Id.*, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.*

We have established that the difference between what Kenney discloses and the claimed subject matter is the afore listed limitations. However, much, if not all, of the afore listed limitations were well known to those of skill in the art at the time the application was filed. For example, although Kenney does not disclose a database, databases attached to websites for categorizing items for display on a screen were well known. It was common knowledge to search a database for items and display the results of that search on a monitor of a client computer. Furthermore, manufacturers commonly attach a manufacturer item part number to items

they produce. Given this knowledge, adding the step of searching a product database by manufacturer part number, as set forth in claim 4, to the Kenney method would have been obvious to one of ordinary skill in the art.

The claimed method appears to be the result of combining well known features in the art commonly known to those of ordinary skill in the art at the time the application was filed with Kenney's process/system. "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1739, 82 USPQ2d 1385, 1395 (2007). In that regard, the record does not include objective evidence of unexpected results.

## DECISION

The decision of the Examiner rejecting claims 1-22 under 35 U.S.C. § 102(e) as being unpatentable over Kenney is reversed.

We remand the application to the Examiner for consideration of a rejection of claims 1-22 under 35 U.S.C. §103(a) over Kenney for the reasons stated supra.

This remand to the Examiner pursuant to 37 CFR § 41.50(a)(1) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

## REVERSED AND REMANDED

vsh

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